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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,459	04/13/2004	Katsuyuki Ogura	KIN-15462	4592
40854	7590	10/19/2005	EXAMINER	
RANKIN, HILL, PORTER & CLARK LLP 4080 ERIE STREET WILLOUGHBY, OH 44094-7836			COURSON, TANIA C	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/823,459	OGURA, KATSUYUKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tania C. Courson	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2005 and 26 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are 'allowed'.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s):

- a) claim 1, lines 4-5, "the movable body moving at least one of a probe";

No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. With respect to claim 8: A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required,

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or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instances, independent claim 1 recites the broad recitation “the movable body moving at least one of a probe and a workpiece”, and the dependent claim 8 recites “said movable body is a table” which is the narrower statement of the range/limitation. If claim 8 is as such, then how can the “movable body” move both a probe as well as a workpiece.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matzkovits (US 5,867,916) in view of Tano (US 6,427,355 B1).

Matzkovits discloses a coordinate measuring machine including the following:

- a) a base (5) that slidably supports a movable body (4) and a guide rail (6) provided on the base and having a guide surface on which the movable body is slidably supported (Fig.1), and the movable body (4) adapted to slide via an air bearing device on the guide surface of the guide rail (column 5, lines 45-60), the movable body moving at least one of a probe (1) and a workpiece in

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- measuring a workpiece, wherein said guide rail is monolithically formed with said base (Fig. 1);
- b) wherein a flat guide surface is formed on a surface of said base (Fig. 1), and the guide rail is monolithically formed with said base on the guide surface (Fig. 1);
  - c) wherein said guide rail has two guide surfaces adjoining each other with a ridge line therebetween (Fig. 1);
  - d) wherein one of the two guide surfaces of said guide rail is a horizontal one, and the other is a vertical one (Fig.1);
  - e) wherein a pair of guide rails are provided in parallel to each other (Fig. 1), the horizontal guide surfaces of the guide rails are provided on the same plane (Fig. 1), and the vertical guide surfaces of the guide rails are provided at positions opposed to each other (Fig. 1);
  - f) wherein said measuring machine is a three-dimensional measuring machine (Fig. 1) for carrying out three-dimensional measuring with said base and said movable body (Fig. 1).

Matzkovits does not disclose a coating film for rust prevention is formed on a surface, and wherein said coating film is made of ceramics.

Tano teaches a measuring device that consists of a coating film (column 3, lines 14-18) for rust prevention is formed on a surface (column 3, lines 14-18) and wherein said coating film

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is made of ceramics (column 3, lines 14-18). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the coordinate measuring machine of Matzkovits, so as to include a coating film, as taught by Tano, so as to improve the performance and reliability of the device (column 1, lines 66-67).

With respect to claim 8: the prior art of record has not been applied to claim 8 due to the narrower description as stated above in paragraph 3.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matzkovits and Tano, as applied to claims 1-2 and 4-9, as stated above.

Matzkovits and Tano disclose a coordinate measuring machine as stated above in paragraph 5.

They do not disclose wherein a coating film is formed by means of plasma spray-coating.

Regarding claim 3: Where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with the evidence establishing an unobvious difference between the two. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

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***Allowable Subject Matter***

7. Claim 8 (applicable to section of “the movable body moving a workpiece in measuring a workpiece”) would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a coordinate measuring machine:

Kikuchi (US 2005/0160612 A1)

Shivaswamy et al. (US 6,941,669 B2)

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DIEGO F.F. GUTIERREZ  
SUPERVISORY PATENT EXAMINER  
GROUP ART UNIT 2859

TCC  
October 14, 2005